

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-22 are pending in the application, with claims 1, 7, 9, 15, and 16 as being the independent claims. No claims are sought to be cancelled. No new claims are sought to be added. These new claims introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-17 have been rejected under 35 U.S.C. §102(e) as being anticipated by Published U.S. Patent Application No: 2001/0054074, entitled *Electronic Mail System and Device*, filed by Kiyoko Hayashi on March 8, 2001 ("Hayashi Patent Application"). Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

On Nov. 1, 2005, Applicants submitted a 37 C.F.R. 1.131 Declaration that demonstrated a reduction to practice of the present invention prior to March 8, 2001. As a result, the Hayashi Patent Application does not qualify as a valid reference to serve as a basis to reject the claims of the present invention.

In the present office action, the Examiner has indicated that evidence submitted by Applicants in a 37 C.F.R. §1.131 Declaration was insufficient to establish a reduction

to practice prior to the effective date of the Hayashi Patent Application. Specifically, the Examiner stated:

(1) The evidence does not indicate whether it is an actual reduction to practice or a constructive reduction to practice.

In response to point (1), Applicants confirm that an actual reduction to practice of the invention prior to March 8, 2001 did occur. Applicants respectfully note that the Declaration of Virad Gupta, Shital Mehta and David Israel under 37 C.F.R. § 1.131 ("Declaration") does demonstrate that an actual reduction to practice the invention prior to March 8, 2001 occurred. Specifically, the Declaration notes that the "software used to implement the invention was checked into the repository before March 8, 2001." Declaration at 1. The Declaration also notes that "the invention was reduced to practice prior to the earliest filing date" of the Hayashi Patent Application. *Id.*

The Examiner also stated:

(2) The evidence does not provide sufficient evidence showing any of the following:

(a) >(actual)< reduction to practice of the invention prior to the effective date of the reference; or

(b) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(c) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction of practice).

(3) The evidence does not provide sufficient evidence showing the claimed invention as set forth in the application.

In response to points 2 and 3, Applicants respectfully observe that the Declaration included two exhibits that provide sufficient evidence to demonstrate that actual reduction to practice occurred prior to March 8, 2001. Exhibit A included a redacted excerpt of a document repository that showed the dates for the design document corresponding to the present invention. Exhibit B included a redacted excerpt of a source code repository that showed the dates for the source code used to implement the present invention, which corresponded to the design document highlighted in Exhibit A.

Applicants herein submit the proxyserversDD.doc that was referenced in Exhibit A to further demonstrate an actual reduction to practice of the present invention prior to March 8, 2001. The proxyserversDD.doc represents the design document upon which the source code, referenced in Exhibit B, was developed. Section 1.1 of the proxyserversDD.doc discloses independent claim 1. Specifically, Section 1.1 notes that email messages will be stored on an email server and that voice and fax messages will be stored on a separate storage system referred to as Harmony. This discloses the second element of claim 1 of storing on a mass storage device a media component. Section 1.1 notes that there will be an email on the email server for each voice/fax message containing proprietary header which contains a pointer to the voice/fax message on the storage device, referred to as NAS. This discloses the third element of claim 1 of storing on an email server said non-media component of said message a corresponding reference to said stored media component of said message. The first element of claim 1 of receiving a message with a media and non-media component can be inferred from

Section 1.1. The proxyserverDD.doc similarly discloses the elements of independent claims 7, 15, and 16.

Applicants submit that they have provided a clear explanation of the exhibits that point out exactly what facts are established and relied upon by Applicants to demonstrate an actual reduction to practice prior to March 8, 2001. Having demonstrated a date of invention prior to March 8, 2001, Applicants respectfully submit that the Hayashi Patent Application does not qualify as a valid reference. Therefore, Applicants respectfully submit that claims 1-17 are patentable over the Hayashi Patent Application. Reconsideration and withdrawal of the rejections of claims 1-17 is respectfully requested.

Claims 18-22 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Hayashi Patent Application in view of U.S. Patent Application No. 2001/0047289. ("Prahlaad Patent Application"). Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

As explained above, the Hayashi Patent Application is not a valid reference upon which a rejection can be based. The Examiner alleges that the Prahlaad Patent Application only discloses a storage device and email device being physically separated. Therefore, claims 18-22 are patentable over the combination of the Hayashi Patent Application and the Prahlaad Patent Application.

Notwithstanding the above showing that the Hayashi Patent Application does not qualify as a valid reference, Applicants respectfully disagree with the Examiner's conclusion that arguments presented in the Applicants' previous responses to Office

Actions did not overcome the Examiner's rejections based on the Hayashi Patent Application. Even if the Hayashi Patent Application was a valid reference, Applicants do not acquiesce to the Examiner's allegations that the claims of the present invention would be anticipated or obvious in light of the Hayashi Patent Application.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Michael D. Specht
Attorney for Applicants
Registration No. 54,463

Date: 5/30/06

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
537696_1.DOC



Proxy Servers Design Document

1 Scope:

Proxy servers will help in following:

1. Single message store
2. Message deletion
3. Quota management

1.1 Single Message Store

We want to maintain a single message store with all email messages being stored on the email server and all voice and fax messages being stored on Harmony(current storage solution being NAS). There will be an email on the email server for each voice/fax message containing the proprietary header which contains a pointer to the voice/fax message on NAS. When the user is accessing his mails from the phone, voice-mail application will look at the proprietary header for the pointer to the voice/fax file and play the actual file from the NAS. But if email clients access the mail server directly then all they will get is a email header without any voice content.

To solve this problem we need IMAP and POP proxy servers which sit between email server and the email clients and whenever an IMAP or POP client asks for these special email messages, these proxy servers will actually attach the voice/fax file with these special email messages. This will ensure that email clients get these voice and fax attachments along with their email.

1.2 Message Deletion

IMAP proxy server will catch "EXPUNGE" and "CLOSE" commands and will fetch the proprietary message header(X-IPMsgID) for all the messages which were marked "DELETED". After getting these proprietary headers, the proxy will actually issue the requested command from the client ("EXPUNGE" or "CLOSE"). These proprietary header information will be sent to message deletion task for further processing.

1.3 Message Quota

The functionality is exactly the same as above. Only addition being that proxy servers will also have to get message size from the proprietary header X-IPMsgSize and send it to the message deletion task.

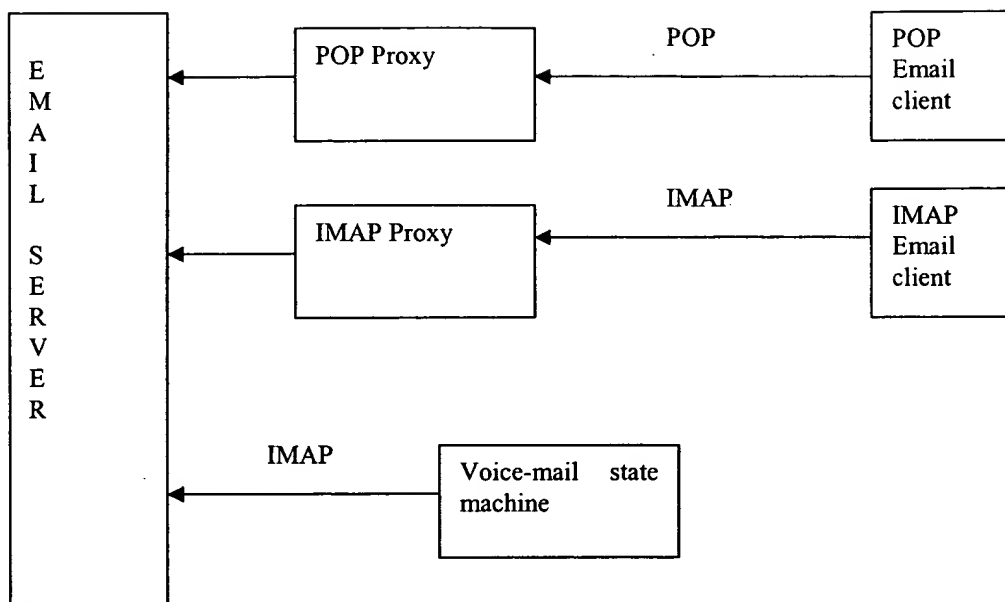


Diagram 1: Proxy servers

Note: Voice-mail state machine will directly talk to Mail server and will not go through IMAP proxy. This is because it does not need to retrieve voice/fax attachments when getting messages from the email server.

2 Design Overview

2.1 IMAP proxy server

Proxy server will receive IMAP requests from the client. These requests will be passed to the IMAP4 server provisioned in the proxy. In turn the response received from the server will be passed back to the client. These will be true for most of the IMAP4 requests received. Some of the IMAP4 request and responses will undergo special processing to support the features such as single message store, message deletion and quota management. These IMAP4 requests and their responses which require special processing are described in brief here.

2.1.1 All FETCH requests and responses

FETCH requests will be of the form:

FETCH <message set> <message data item names> or
 UID FETCH <message set> <message data item names>

The current design does not take into account the FETCH of independent message parts. The proxy server will support the attachment of voice files only if the whole message body is requested. So whenever there is a FETCH request for the full message body, the proxy will parse the response coming from the mail server. It will decide whether a message is voice/fax depending on the presence of the proprietary message header "X-IPMsgID". So when the server responds with dummy attachments for these voice/fax messages, the proxy will replace them with the actual voice/fax files which will be determined based on "X-IPMsgID" header.

Note:

1. X-IPMsgID should be present in the top most message of the mime structure. A message which does not have this proprietary header in the top most messages but has it somewhere in its body parts will not be treated as a voice/fax message but only as an ordinary email. This will happen when a voice messages is being replied to or forwarded by an email client. As soon as a voice/fax message is replied by or forwarded by an email client it will cease to be a voice/fax message and will be ordinary email only.
2. X-IPMsgID will have multiple message ids. This header will contain all the message ids for the voice messages in the current message and its extensions. The last message id will be the id for the voice/fax part of the current message.

2.1.2 “EXPUNGE” and “CLOSE” requests

The proxy server will trap all “EXPUNGE” and “CLOSE” requests to provide message deletion information to the application server.

Currently we are supporting only “INBOX”, so the proxy server will trap these messages only for the “INBOX” folder.

After trapping these commands, the proxy server will issue commands to the Mail server to find out how many voice/fax messages will get deleted and fetch proprietary headers for all of them.

Client to proxy : EXPUNGE/CLOSE

Proxy to server : uid search deleted header X-IPMsgID “”

Server to proxy : search 29 30

Proxy to server : uid fetch 29,30 body.peek[header.fields (X-IPMsgID X-IPMsgSize)]

Server to proxy : * 5 FETCH (UID 29 BODY[HEADER.FIELDS X-IPMsgID X-IPMsgSize]) {48}

X-IPMsgID: 972456789801 972456789823

X-IPMsgSize: 3120

)

* 6 FETCH (UID 30 BODY[HEADER.FIELDS X-IPMsgID X-IPMsgSize]) {48}

X-IPMsgID: 972456789810

X-IPMsgSize: 3120

)

Proxy to server: EXPUNGE/CLOSE

.....

Then proxy server will forward all these information about the messages deleted to the Application server.

2.1.3 Add message waiting mechanism